

REMARKS

Applicant submits this Reply to the final Office Action mailed August 24, 2007. By this Reply, Applicant has amended claims 1, 12, 22, 32, 35, and 42, and cancelled claims 33, 34, and 36. Accordingly claims 1-32, 35, and 37-42 remain pending. The originally-filed specification, drawings, and claims fully support the subject matter of amended claims 1, 12, 22, 32, 35, and 42. Thus, the claim amendments introduce no new matter.

In the Office Action, claims 1-6, 8, 10-16, 18, 20-27, 29, 31-37, 39, and 41 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,208,979 to Sinclair ("Sinclair"); claims 9, 19, 30, and 40 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sinclair; and claims 7, 17, 28, and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sinclair in view of U.S. Patent No. 6,112,190 to Fletcher et al. ("Fletcher"). Applicant respectfully traverses the rejection for the reasons provided below.

Applicant noted in remarks filed May 22, 2007, that the Office Action did not address independent claim 42. The final Office Action also fails to address independent claim 42. Applicant respectfully requests clarification regarding the rejection of claim 42, as indicated on the Office Action Summary page. Applicant also respectfully requests that the finality of this Office Action be withdrawn since claim 42 has not been addressed either by setting forth a grounds of rejection or an indication of allowable subject matter. As claim 42 has not been addressed on its merits, the finality of this Office Action is premature.

Sinclair does not disclose each and every element of Applicant's claimed features. For example, claim 1 recites "[a] computer based method for automatically creating a list of financing documents for a transaction," including *inter alia* "preparing the decision criteria document, the decision criteria document having a plurality of data fields to be completed; receiving completed data fields; developing a set of selection criteria; and automatically choosing a required set of documents based on the selection criteria and preparing the list of financing documents."

Sinclair discloses "[a] computer-driven information management system [that] selectively matches credit applicants with money lenders through a global communications network." Sinclair, Abstract. Sinclair further discloses that "finance institutions create customized electronic model profiles by entering into the System characteristics they judge to be indicative of a 'desirable' credit applicant." See Sinclair, col. 7, ll. 31-33. For example, in Sinclair, qualifiers included in the creation of the electronic model profile might be "the applicant's gross monthly income, state where dealer is located, number of months the applicant has been employed at present job, number of years the applicant has been residing at present address, and the like." Sinclair, col. 7, ll. 39-43. In other words, the "customized electronic model profile" in Sinclair refers to creating profiles, according to characteristics deemed by the "finance institutions" to be indicative of a "desirable" credit applicant. Sinclair, col. 7, ll. 31-43.

Sinclair fails to disclose "preparing the decision criteria document, the decision criteria document having a plurality of data fields to be completed; receiving completed data fields; developing a set of selection criteria; and automatically choosing a required set of documents based on the selection criteria and preparing the list of financing

documents,” as recited in claim 1. Although Sinclair discloses “generat[ing] and forward[ing] necessary documents to the finance institution to finalize the loan transaction,” (Sinclair, col. 9, ll. 6-7), Sinclair fails to specifically disclose “developing a set of selection criteria; and automatically choosing a required set of documents based on the selection criteria and preparing the list of financing documents,” as required by claim 1. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(e) of claim 1 and its dependent claims 2-6, 8, and 10-11.

Independent claims 12, 22, and 32, although of different scope, recite features similar to those of claim 1. For example, claim 12 recites, among other things, “preparing the decision criteria document, the decision criteria document having a plurality of data fields as a function of the initial information; receiving completed data fields; generating rules for choosing a required set of documents; and automatically selecting the required set of documents based on the rules and preparing the list of financing documents.” Claim 22 recites, among other elements, a “computer application being adapted to receive a request for a decision criteria document from the finance computer application and prepare the decision criteria document, the decision criteria document having a plurality of data fields to be completed, to receive completed data fields from the finance computer application, to develop a set of selection criteria, and to automatically select a required set of documents based on the set of selection criteria, and prepare the list of financing documents.” Claim 32 recites, among other features, “computer application being adapted to receive a request for a decision criteria document from the finance computer application and prepare the decision criteria document, the decision criteria document having a plurality of data fields to be

completed, to receive completed data fields from the finance computer application, to generate a criteria for selecting a required set of documents based on the completed data fields, and to automatically choose the required set of documents based on the generated criteria and prepare the list of financing documents." As noted above in connection with claim 1, Sinclair fails to disclose or suggest, at least, the above recitations. Accordingly, the rejection of claims 12, 22, and 32 under 35 U.S.C. § 102(e) should be withdrawn. Dependent claims 13-16, 18, 20-21, 23-27, 29, 31, 33-37, 39, and 41 which depend from one of independent claims 12, 22, and 32, are allowable for at least the same reasons claims 12, 22, and 32 are allowable.

Claim 9 depends from 1, claim 19 depends from claim 12, claim 30 depends from claim 22, and claim 40 depends from claim 32. With respect to the 35 U.S.C. § 103(a) rejection of claims 9, 19, 30, and 40 as being unpatentable over Sinclair, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection because a *prima facie* case of obviousness has not been established. A *prima facie* case of obviousness has not been established because, among other things, Sinclair fails to disclose or suggest the features recited in independent claims 1, 12, 22, and 32. Accordingly claims 9, 19, 30, and 40 are allowable for at least the same reasons that claims 1, 12, 22, and 32 are allowable.

Claim 7 depends from 1, claim 17 depends from claim 12, claim 28 depends from claim 22, and claim 38 depends from claim 32. Regarding the 35 U.S.C. § 103(a) rejection of claims 7, 17, 28, and 38 as being unpatentable over Sinclair in view of Fletcher, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection because a *prima facie* case of obviousness has not been established.

For example, as discussed above in connection with claim 1, Sinclair does not disclose "[[a]] computer based method for automatically creating a list of financing documents for a transaction," including *inter alia* "preparing the decision criteria document, the decision criteria document having a plurality of data fields to be completed; receiving completed data fields; developing a set of selection criteria; and automatically choosing a required set of documents based on the selection criteria and preparing the list of financing documents." Fletcher does not cure the deficiencies of Sinclair. Indeed, the Office Action does not rely on Fletcher for disclosing the above recitation. Instead, the Office Action alleges that Fletcher discloses "the step of allowing a user to override the required set of documents." Office Action at 4. Even assuming this allegation is correct, which Applicant does not concede, it does not constitute a teaching the above recitation of claim 1. Moreover, the Office Action does not indicate why the differences between Sinclair and Fletcher and claim 1 would have been obvious to an ordinarily skilled artisan. See MPEP § 2141(III). Accordingly Applicant respectfully requests withdrawal of the Section 103(a) rejection of dependent claim 7. Similarly, as discussed above in connection with independent claims 12, 22, and 32, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejection of dependent claims 17, 28, and 38. In the event that the Examiner does not withdraw the finality of the Office Action, Applicant submits that independent claim 42 is novel and unobvious over the cited references and should be allowed.

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-42 in condition for allowance. Applicant submits that the proposed amendments of claims 1, 12, 22, 32, and 42 do not raise new

issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is not rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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